



**UNITED STATES DEPARTMENT OF COMMERCE
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BCL

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/224,231 12/30/98 SALLEN

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EXAMINER

SWANN III, G

ART UNIT

PAPER NUMBER

2736

9

DATE MAILED:

05/12/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/224,231

Applicant(s)
Sallen et al.

Examiner
Glen R. Swann III

Group Art Unit
2736



☒ Responsive to communication(s) filed on 28 Feb 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire THREE month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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1. The reissue oath/declaration filed with this application is defective because it fails to identify at least one error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.
2. Claims 1-8 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action. It is noted that the Office requires a description of the nature of the “more or less than the patentee has a right to claim in the patent” which was claimed. Example(s) of the excess or insufficient claims should be specified.

3. Claims 5-7 are rejected under 35 U.S.C. 251 as being an improper recapture of claimed subject matter deliberately canceled in the application for the patent upon which the present reissue is based. As stated in *Ball Corp. v. United States*, 221 USPQ 289, 295 (Fed. Cir. 1984):

“The recapture rule bars the patentee from acquiring, through reissue, claims that are of the same or broader scope than those claims that were canceled from the original application.”

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Claims 5 & 7 correspond to claims 1-13 of application S.N. 08/355,041. All of the afore-mentioned claims of application S.N. 08/355,041 were rejected under 35 U.S.C. 102 or 35 U.S.C. 103 and subsequently were deliberately canceled in favor of a claim reciting a combination of encoding and *FM modulation* and relying on this combination of features for patentability, the limitation that the modulation is FM being deleted in claims 5 & 7. Applicants' comment that they are puzzled by the use of the term "combination" in this rejection, since the claims are for a "system" and not for a "combination" is not understood. It is not asserted that the claims are directed to a "system" but rather that the patent claims recite such a combination, which they clearly do and the claims in contention recite a similar combination absent the limitation that the modulation is FM, which they clearly do (lines 10-15 in each case). It is not the same to say a claim *recites* certain limitations (which they clearly do) and that it is *directed* to those limitations (which was never asserted). Even if it were the same, the meanings of "system" and "combination" are similar enough that it is not clear wherein lies the puzzlement.

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4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glen Swann, whose telephone number is (703) 305-4384. He can normally be reached Monday through Thursday from 7:30 AM to 5:00 PM. He is also available on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, his supervisor, Jeffrey Hofsass, can be reached at (703) 305-4717.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group Receptionist at (703) 305-3900.

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Any response to this action should be mailed to:

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Of faxed to:

(703) 308-6296 or (703) 308-6306.

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,
Arlington, VA, Sixth floor (Receptionist).



GLEN SWANN
PRIMARY EXAMINER

SWANN:grs
May 11, 2000